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| 09/603,886 | 06/26/2000 | Roy Sullivan | 10546/56701 | 2146 |

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EXAMINER

SMITH, RUTH S

ART UNIT PAPER NUMBER

3737

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/603,886
Filing Date: June 26, 2000
Appellant(s): SULLIVAN, ROY

MAILED
JAN 12 2006
Group 3700

Fay Kaplun & Marcin, LLP
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 11, 2005 appealing from the Office action mailed March 31, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on May 31, 2005 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The objection to the specification has been withdrawn in view of the entry of the after final amendment filed May 31, 2005.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|------------------|--------|
| 5,868,760 | McGuckin, Jr. | 2-1999 |
| 5,891,133 | Murphy-Chutorian | 4-1999 |
| 4,830,849 | Osterholm | 5-1989 |
| 5,485,839 | Aida et al | 1-1996 |

6,214,018

Kreizman et al

4-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 33-36,40 have been rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin Jr. in view of Murphy-Chutorian. McGuckin Jr. disclose a tissue resectioning system including a resection head 12 mounted at the distal end of a elongate flexible body 16 and diagnostic imager for providing guidance of the resectioning head and a control unit 14. McGuckin Jr. discloses in column 3 that as a result of the flexible nature of the apparatus an operator with ***either endoscopic or diagnostic imaging guidance*** can use the apparatus to perform transmural surgery with resection. McGuckin Jr. further states that the invention is not limited to use with endoscopic or a particular type of diagnostic imaging guidance. The imager can be CT, MRI, Fluoroscopy etc. (see column 3, lines 58-65). McGuckin Jr. fails to disclose the use of a marker. It is old and well known in the art to place a detectable marker on a catheter/tubular body inserted in a patient's body such that the catheter's/tubular body position can be easily located using an imaging device sensitive to the type of marker used. An example of such is seen in Murphy-Chutorian which shows a catheter device in combination with an image detectable marker. The catheter device can include a resecting device as seen in column 5, lines 5-12. The image along with the marker is then displayed to show the operator where the device is positioned. It would have been obvious to one skilled in the art to have modified McGuckin Jr. such that it includes a detectable marker which when imaged enables the operator to visualize the location of the elongate flexible body in the body.

Claim 37 has been rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin Jr. in view of Murphy-Chutorian as applied to claim 33 above, and further in view of Osterholm. Osterholm discloses a medical system having a control device that

will disable the system if the operation of such falls outside of the desired operating parameters. It would have been obvious to one skilled in the art to have further modified McGuckin Jr. such that it includes a means for disabling the system if the marker indicated that the resection device is oriented outside the defined region of tissue in order to ensure that no harm comes to the patient if the resection device moves out of the region of interest.

Claims 38-39 have been rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin Jr. in view of Murphy-Chutorian as applied to claim 33 above, and further in view of Aida et al. Aida et al disclose a system having a control tissue therapy system that includes an alarm means to notify a user of a deviation from the treatment plan. The alarm can either be in the form of a visual or audio signal. It would have been obvious to one skilled in the art to have further modified McGuckin Jr. such that it includes an alarm means in order to ensure that no harm comes to the patient if the resection device moves out of the region of interest.

Claims 41,42 have been rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin Jr. in view of Murphy-Chutorian as applied to claim 33 above, and further in view of Kreizman et al. McGuckin Jr. fails to disclose the use of an automatic control unit for controlling operation of the resectioning device and the specific manner in which the defined region is determined. Kreizman et al disclose a resectioning device having a control system that controls operation of the resection device by determining the defined region of tissue and moving the device to the desired location. It would have been obvious to one skilled in the art to have further modified McGuckin Jr. such that it includes a controller that will automatically determine the desired region of interest and move the resecting head to that location. The advantage of such is to eliminate the chance of operator error. In the absence of any showing of criticality or unexpected results, the manner in which the defined region of interested is determined would have been an obvious matter of design choice of known functional equivalents in the art.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

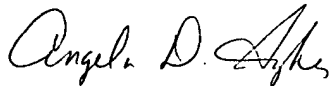
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**Ruth S. Smith
Primary Examiner**

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